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First Named Inventor	Russell D. Slifer	TRANSMITTAL FORM
Serial No.	08/970,258	
Filing Date	November 14, 1997	
Group Art Unit	3713	
Examiner Name	S. Clayton	
Attorney Docket No.	106.001US01	
Title: PERSONALIZED WIRELESS VIDEO GAME SYSTEM		

Commissioner for Patents and Trademarks
Box 8
Washington, DC 20231

Enclosures

The following documents are enclosed:

An Appeal Brief (includes Table of Contents, plus pp. 1-7 for Brief, pp. 8-12 for Appendix A) IN TRIPLICATE

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Slifer	)	Group Art Unit: 3713
Serial No.:	08/970,258	)	Examiner: S. Clayton
Filed:	November 14, 1997	)	Atty. Docket No.: 106.001US01

For: PERSONALIZED WIRELESS VIDEO GAME SYSTEM

APPEAL BRIEF

Commissioner for Patents
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Washington, D.C. 20231

Table of Contents

I. Introduction

Appellant filed a Notice of Appeal to the Board of Patent Appeals and Interferences on September 6, 2000. Three copies of this Appeal Brief are hereby timely filed on November 6, 2000, and are accompanied by a fee in the amount of $ 150.00 as required under 37 C. F. R. section 1.17(f).

II. Status of the Claims

In the most recent Office Action dated June 6, 2000, claims 1-18 and 20 stand rejected under 35 U.S.C. § 103 and as being obvious over a single reference.

III. Status of Amendments

This application was originally filed on November 14, 1997 with claims 1-20.

In the first Office Action mailed February 16, 1999 (Examiner Clayton) rejected claims 1-20. In response to the first office action, claim 19 was canceled and claims 1, 9, 16 and 20 were amended.

A final Office Action mailed September 2, 1999 (Examiner Clayton) rejected claims 1-18 and 20 based on a different rejection. In response to the final office action, a response mailed on November 2, 1999 claim 20 was canceled and claims 1, 9 and 16 were further amended.

A second final Office Action mailed June 6, 2000 (Examiner Clayton) rejected claims 1-18 and 20 (previously cancelled) based on the same rejection set forth on September 2, 1999.

Claims 1-18 are pending and provided in Appendix A.

IV. Summary of the Invention

The invention relates to game controllers, and more particularly wireless game controllers for video-type games. The controller embodiments, as set forth in the claims, include a non-volatile memory that stores a user's age and the user's historical game performance. The controller is personalized and can be portably moved to different game controllers while maintaining updated performance information and authorization of game participation based on the user's age, see Application page 4, line 26 to page 5, line 8.

V. Issue

Are claims 1-18 patentable under 35 USC §103(a) in view of Lemelson et al. U.S. Patent No. 5,823,788.

VI. Grouping of Claims

Claims 1-18 stand or fall under 35 U.S.C. § 103 on their own merit for the reasons detailed below.

Each of these claims are patentably distinct under 35 U.S.C. § 103.

VII. Arguments

1. The Claims

Claims 1-6, 9-13 and 16

The Examiner rejected the pending claims as being obvious in view of a single reference, Lemelson et al. U.S. Patent No. 5,823,788 (Lemelson '788). Lemelson '788 discloses a classroom interactive system where a teacher can ask questions of the class and receive real-time

feedback. A processor is used to track the responses from wired or wireless student stations. Each station has an identifier that can be used to identify the student using the station.

The Examiner's rejection does not establish a prima facie case of obviousness, as explained herein. First, the Examiner states on pages 5 and 6 of the Final Office Action (paper 9) that Lemelson '788 discloses essentially all of the claimed invention. Specifically, the Examiner states that Lemelson '788 discloses an instructional system including a base station and student stations. Each student station has a keyswitch to transmit responses to instructor questions. The student stations include an identifier code to indicate which station provided a specific answer. The base station can then track responses by the class and each student station.

The Examiner then states that it would have been obvious to use teachings of Lemelson '788 in a game because a classroom is basically a question and answer game. This statement appears to be a justification by the Examiner that Lemelson '788 is within an applicable art area. The Examiner has not, however, applied the reference to all of the elements of the pending claims.

Specifically, claims 1, 9 and 16 recite a non-volatile memory to store personal identification information comprising a user's age and historical game performance data. The Examiner cites column 4, lines 2-46 of Lemelson '788 as teaching student identification. This portion of Lemelson '788 does not teach the claimed elements. In fact, the unique station identifier of each student station does not identify the user directly. Instead, the reader of Lemelson '788 must assume that the base station uses the student station identification to cross-reference to a student. Further, Appellant amended claims 1, 9 and 16 to eliminate the storage of a user's name in the claimed invention. Thus, the Examiner is rejecting the claims based upon withdrawn claim language.

The Examiner has failed to address the storage of historical game performance in the present invention. The student station of Lemelson '788 allows for display of questions, but does not teach or suggest storage of a student's performance in the student stations.

The Examiner has completely ignored the storage and use of a user's age in claims 1-6, 9-13 and 16. The Examiner has attempted to address similar claim language that was contained in canceled claim 20, see Paper 9 pages 4-5. The Examiner concludes that it would have been obvious to allow a teacher to restrict participation so that the game (class) can be tailored to a user's understanding or age. This conclusion is completely void of suggestion from Lemelson '788. In fact, because Lemelson '788 describes a classroom setting, one skilled in the art would assume that registration for a class would establish pre-requisites for participation. Thus, the Examiner has failed to establish motivation for modifying Lemelson '788 to allow the student stations to store a user's age. Any suggestion of these elements can only be obtained from the present invention using inappropriate hindsight reconstruction, see Application page 5, lines 8-9. Further, claim 16 requires transmission of a user's age from the controller and then authorizing operation of a game based upon the age. These elements are neither taught nor suggested by Lemelson '788.

In conclusion, the Examiner has merely provided an argument that Lemelson '788 is appropriately applied to the present claims. The Examiner, however, fails to provide any support for modifying the reference to address all of the claim language. Ignoring the storage of historical performance data in the claimed controller fails to establish a prima facie case of obviousness. Concluding that age may be a factor in a class does not suggest a modification of Lemelson '788 to provide a personal game controller which stores age data that can be used to authorize participation in a game.

2. Applicable Law

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to

> solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) — in other words, common sense — in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In Re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992).

Once appropriate prior art in the field has been identified, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985). The test of obviousness is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention, In re Gorman, 933 F.2d at 986, 18 USPQ2d at 1888, and what the combined teachings . . . would have suggested to one of ordinary skill in the art, In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Further, the prior art as a whole must suggest the desirability . . . of making the combination. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See In re

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness. See id.

> A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

In re Kotzab, ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir. 2000) (No. 99-1231)

> Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See Id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See Id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Id.

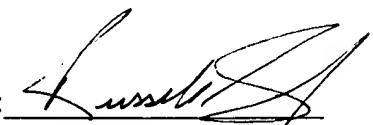
Finally, simplicity is not unfavorable to patentability. See Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 279, 60 USPQ 386, 388 (1944) (simplicity of itself does not negative invention); Panduit Corp. v. Dennison Mfg Co., 810 F.2d 1561, 1572, 1 USPQ2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), cert. denied, 481 U.S. 1052 (1987).

VIII. Conclusion

Appellant has set forth reasons why the Examiner is incorrect in maintaining the rejections of the pending claims. Appellant believes that the Examiner has failed to establish a prima facie case of obviousness.

For at least the reasons discussed above, Appellant submits that pending claims are patentable. Accordingly, Appellant requests that the Board of Appeals reverse the Examiner's decisions regarding the claims.

Respectfully submitted,

Date: 10/26/06 By: 

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APPENDIX A

CLAIMS ON APPEAL

1. A video game system comprising:

a processor unit for executing game instructions and displaying video images on a display screen, the processor includes a receiver for receiving wireless identification and control signal transmissions; and

a personalized portable controller comprising:

a plurality of control switches for generating game control signals;

a non-volatile memory for storing personalized identification information corresponding to a user of the controller, the personalized identification information comprises a user age, and historical game performance data; and

a transmitter for wireless transmitting of the personalized identification and game control signals to the processor unit, wherein the processor unit authorizes game execution based on the user age, further the processor unit comprises a transmitter for transmitting the historical game performance data to the personal portable controller.

2. The video game system of claim 1 wherein the processor unit further comprises a memory for storing user information corresponding to a plurality of possible users.

3. The video game system of claim 2 wherein the user information stored in the memory of the processor unit is retrieved for use by the processor unit in response to the identification signal

transmitted by the personal portable controller.

4. The video game system of claim 3 wherein the identification signal is transmitted from the personalized portable controller with a transmission of each control signal.

5. The video game system of claim 2 wherein the user information stored in the memory of the processor unit is down loaded from the personalized portable controller prior to the operation of a video game.

6. The video game system of claim 1 further comprising:

a wireless transmitter located in the processing unit for transmitting updated information to the personalized portable controller; and

a receiver located in the personalized portable controller for receiving the updated information for storage in the non-volatile memory on the personalized portable controller.

7. The video game system of claim 1 wherein the personalized portable controller includes a removable rechargeable battery pack.

8. The video game system of claim 1 wherein the personalized portable controller includes power saver circuitry for reducing the power consumption of the controller of when the controller is not in use.

9. A personalized portable video game controller comprising:

a wireless transmitter for transmitting user personalized information and video game control signals to a video game processor, the personalized identification comprises a user age, and historical performance data;

a plurality of input controls for generating the control signals in response to movements by a user;

a non-volatile memory for storing the user personalized information; and

a receiver for receiving wireless transmissions from the video game processor, the received wireless transmissions including the historical performance data to be stored in the non-volatile memory.

10. The personalized portable video game controller of claim 9 wherein at least a portion of the user personalized information is transmitted to the video game processor with each control signal transmissions.

11. The personalized portable video game controller of claim 9 wherein the user personalized information is selected from the group comprising user name, video game skill level, video game operating preferences, video game scores, or user age.

12. The personalized portable video game controller of claim 9 wherein the user personalized

information is updated during video game operations via wireless transmissions from the video game processor.

13. The personalized portable video game controller of claim 9 wherein the user personalized information is transmitted from the controller to the game processor prior to interactive operation of a video game.

14. The personalized portable video game controller of claim 9 further comprising a removable rechargeable battery pack.

15. The personalized portable video game controller of claim 14 wherein the personalized portable controller includes power saver circuitry for reducing the power consumption of the controller when the controller is not in use.

16. A method of operating an interactive video system, the method comprising:

activating a processing unit;

transmitting personalized information from a controller using wireless transmissions, the personalized identification information comprising a user age, and historical performance data;

storing the personalized information in a memory of the processing unit;

authorizing operation of a video game based upon the user age;

transmitting updated personalized information from the processing unit to the controller

using wireless transmissions; and

storing the updated personalized information in a memory of the controller

17. The method of claim 16 wherein the personalized information is transmitted from the controller prior to interactive operation of a video game.

18. The method of claim 16 wherein the updated personalized information is transmitted during interactive operation of a video game.